

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

F-802

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Signature _____

Typed or printed name _____

Application Number

10/803,636

Filed

March 18, 2004

First Named Inventor

John W. SUSSMEIER

Art Unit

3724

Examiner

Prone, J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

Christopher H. Kirkman
Signature

☐

assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

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* Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	Date: July 31, 2007
Appellants : John W. SUSSMEIER et al.	Attorney Docket : F-802
Application No. : 10/803,636	Customer No. : 00919
Filed : March 18, 2004	Confirmation No. : 5369
Examiner : Prone, J.	Group Art Unit : 3724
Title : SYSTEM AND METHOD FOR PROVIDING SHEETS TO AN INSERTER SYSTEM USING A HIGH SPEED CUTTER AND RIGHT ANGLE TURN	

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellants hereby request a pre-appeal brief conference for review of the sufficiency of the rejection made in the final Office Action mailed May 1, 2007. For the reasons discussed below, Appellants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

REMARKS

I. Status of the Claims

In the final Office Action, claims 1, 2, 4-9, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,443,447 to Ifkovits et al. in view of U.S. Patent No. 5,439,208 to Moser et al. Claims 3 and 10 were objected to, but were indicated as being allowable if rewritten in independent form, etc.

II. A Prima Facie Case of Obviousness Has Not Been Established

According to M.P.E.P. § 2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974)), “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” Because Ifkovits and Moser fail to teach or suggest Appellants’ claimed combination recited in independent claims 1 and 8, Appellants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

A. Ifkovits fails to teach or suggest all the limitations of claims 1 and 8

Ifkovits teaches a sheet accumulating system “to increase the overlapped amount of cut sheets in a continuous web cutter and a right angle transport device so as to increase the collating efficiency of a sheet accumulator.” Ifkovits at col. 1, lines 56-59. This is carried out by moving the sheets 41, 42 (see Fig. 2) with “**different speeds.**” Id. at col. 4, lines 17-19. (Emphasis added.) The different speeds are achieved using “different mechanical advantages on pulley systems 140, 160.” Id. at lines 51-54 and Figs. 6a-6c.

Ifkovits fails to teach or suggest a “right angle turn transport transporting individual sheets at a first velocity, the first velocity being a function of the cutting rate

multiplied by the width of the individual sheets,” as recited in claim 1. Further, Ifkovits fails to teach or suggest “transporting the individual sheets at a first velocity. . . the first velocity being a function of the cutting rate multiplied by the document width,” as recited in claim 8.

For example, according to the Specification of the instant application, the right angle turn transport (37) includes “rollers 23, 24, 36, and turn bars 32 and 33.” Specification at page 11, lines 20-21. See also Fig. 2. In the device of Ifkovits, the corresponding components transport sheets at **two different speeds**, as discussed above, not “at a first velocity,” as claimed.

Further, there is no teaching or suggestion in Ifkovits of controlling either of the two transport speeds to be a “function of the cutting rate multiplied by the width of the individual sheets,” as recited in claim 1 or to be a “function of the cutting rate multiplied by the document width,” as recited in claim 10.

B. The Examiner concedes that the claim limitations are not met

The Examiner stated in the final Office Action at page 4, “the width of the work pieces in Ifkovits et al. is too wide to meet the formula at issue.” Appellants agree and additionally point out that there is no teaching whatsoever in the Ifkovits reference of controlling the velocity of the sheets as claimed. Rather, Ifkovits teaches a “web cutter” having a “first movement mechanism for moving the first sheet. . . with a first moving speed” and a “second movement mechanism for moving the second sheet. . . with a second moving speed greater than the first moving speed.” Ifkovits at col. 2, lines 3-9.

C. The arguments against patentability are unsupported assertions

The Examiner's arguments in the final Office Action are unsupported by the references and by the knowledge of one of ordinary skill in the art and are, therefore, insufficient to form the basis of a prima facie case of obviousness.

For example, regarding claim 1, it was asserted at page 4 of the Office Action that:

“the combination of Ifkovits et al. in view of Moser et al. has a first velocity and it is capable of performing its intended use on a work piece that has a width that corresponds to the first velocity being a function of the cutting rate multiplied by the width of the individual sheets.”

It was further asserted at page 4 that the “apparatus disclosed by Ifkovits et al. is perfectly capable of performing its intended use on a work piece that has the width that meets the formula.”

Appellants respectfully submit that the Ifkovits reference, as modified by Moser, fails to teach or suggest the structural and method elements recited in claims 1 and 8, respectively, and that the “intended use” of the device of Ifkovits is irrelevant to that claimed subject matter.

Further, regarding claim 8, it was asserted at page 4 that the “first velocity would have to be dependent on the cutting rate because if the first velocity were too fast or too slow the cut would not be perpendicular to the feed direction.” Appellants point out that Ifkovits teaches a “guillotine cutting module” (see col. 1, line 20), through which the web proceeds in a stop and start motion guided by “tractor pins 12” (see col. 3, lines 52-54), as is known in the art. Thus, contrary to the Examiner's assertion, the velocity of the advancing web is irrelevant to the orientation of the cut of the web.

D. Moser fails to overcome the deficiencies of Ifkovits

In the final Office Action, Moser was cited for its teaching of a “high speed separation transport.” Final Office Action at page 3.

Appellants respectfully submit that, even if the device of Ifkovits were modified as suggested in the Office Action, the modified device would fail to teach or suggest a “right angle turn transport transporting individual sheets at a first velocity, the first velocity being a function of the cutting rate multiplied by the width of the individual sheets,” as recited in claim 1, or “transporting the individual sheets at a first velocity. . . the first velocity being a function of the cutting rate multiplied by the document width,” as recited in claim 8, for the reasons set forth in paragraphs A-C above.

III. Conclusion

Appellants respectfully request that the conference panel reconsider this application, withdraw the claim rejection, and allow the pending claims in a timely manner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 16-1885.

Respectfully submitted,

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